UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	0054-011P1	5831

40972 7590 10/03/2008
HENNEMAN & ASSOCIATES, PLC
714 W. MICHIGAN AVENUE
THREE RIVERS, MI 49093

EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
10/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/606,729	DONIAN ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-108* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-108* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/29/03,7/19/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 62-80 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything, which would not also infringe the basic claim. If independent claim recites a method of making a specified product, a claim to the product set forth in the independent claim would not be a proper dependent claim since it is conceivable that the product claim can be infringed without infringing the base method claim if the product can be made by a method other than that recited in the base method claim. Claims 62-80 are not proper independent claims since the claims incorporate all the limitations of an independent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 45-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. Claims 45-48 recite "a method according to Claim 1, further comprising ***receiving media file identifiers associated with media files that should no longer be presented***; further comprising ***receiving media file identifiers associated with media files that are not be transferred***; further comprising ***receiving media file identifiers associated with media files that are to be removed from said user's system***; further comprising ***receiving a new media file identifier associated with a new media file that should be substituted for an existing media file***.

The specification teaches that the program identifies a media content item on the basis of a unique universal identifier stored in any number of locations, including, but not limited to, local database 562 and/or the media file itself. The specification further teaches that the program then uses the identifier to locate the item by first going to local database 562, and if not found, to media catalog 566. The specification however does not teach how the identifier is transmitted or transferred and presented. Therefore, the claims are rejected as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-61 and 104-108 are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter. 35 U.S.C 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or

composition of matter, or any new and useful improvement thereof" (emphasis added). Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing, and the steps recited in the claims can be performed in the mind of the user or by the use of a pencil and paper.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Strietzel (US 6,950,804).

Regarding claims 1, 62, 81, 102, 103, 107 and 108, Strietzel teaches receiving at least one ad file; receiving input indicative of a user's selection of at least one media file; receiving a copy of said media file; and presenting said media file content and said ad file content to said user (see col. 10 lines 33-67).

Regarding claims 2, 3, 63, 82 and 83, Strietzel teaches receiving another ad file; and re-presenting said media file content to said user with said another ad file content; receiving a plurality of ad files; and said step of presenting said ad to said user includes selecting said ad file from said plurality of ad files (col. 4 lines 14-24).

Regarding claims 4-6, 64-66, 84 and 85, Strietzel teaches wherein said ad file is selected based at least in part on said media file content; receiving demographic information from said user; and wherein said ad file is selected at least in part based on said user demographic information; wherein said ad file is selected based at least in part on a marketing preference (see col. 7 line 1-25, col. 10 lines 13-67).

Regarding claim 7, Strietzel teaches wherein said ad file is selected based at least in part on a geographic location (see col. 14 lines 59-67).

Regarding claims 8-17 and 67-70 Strietzel teaches wherein said ad file is selected based at least in part on a time of day; based at least in part on a position of presentation of ad file content with respect to said media file content; based at least in part on a position of presentation of said ad file content with respect to other ad file content; based at least in part on a number of said media files to be presented; based at least in part on other ad files being presented with said media file content; based at least in part on a format of said media file content; further

comprising making a record of ad files that have been presented to said user (see col. 4 lines 14-33, col. 10 lines 1-67, col. 11 lines 1-35).

Regarding claims 18-23 and 71-73, Strietzel teaches transmitting said ad file presentation records to a provider of said ad files; selecting subsequent ad files based at least in part on said ad file presentation records (see col. 15 lines 1-33); receiving a plurality of ad files; said step of receiving input indicative of a user's selection of at least one media file includes receiving a list of media files; and said step of receiving a copy of said media file includes receiving a copy of each media file in said list of media files; wherein said step of resenting said media file content with said ad file content includes: arranging said ad files into ad blocks; presenting the content of said media files included in said list; and interrupting the presentation of said media file content with the presentation of the content of said ad blocks at predetermined points; altering the order of presentation of the content of said media files responsive to input from said user; and altering said predetermined points for presenting said ad block content based on the altered order of presentation of the content of said media files; further comprising: receiving input indicative of said user's desire to re-present the media files included in said list; generating new ad blocks; and presenting said media file content with the content of said new ad blocks (see col. 4 lines 14-33, col. 10 line 1-67, col. 13 line 50 to col. 14 line 33).

Regarding claims 24-39, 74-77 and 91-99, Strietzel teaches altering the order of presentation of the content of said media files responsive to input from said user; and altering said ad block content based on the altered order of presentation of the content of said media files (see col. 6 lines 5-28); wherein said step of presenting said media file content and said ad file content includes associating an ad requirement with said media file; and presenting sufficient ad

file content to satisfy said ad requirement (col. 13 line 50 to col. 14 line 58); wherein said ad requirement depends at least in part on the length of said associated media file content; wherein said ad requirement is predetermined for said associated media file; wherein a value indicative of said ad requirement is included in said associated media file; wherein an ad requirement associated with a particular media file is set to indicate that no ad content is required after said particular media file content has been presented with ad file content a predetermined number of times (see col. 4 lines 1-33, col. 10 lines 47-67); wherein said ad requirement depends at least in part on a service level associated with said user; said media file content is presented in a first format; and said ad file content is presented in a second format different from said first format; said first format is print and the second format is audio (see col. 10 lines 1-48, col. 14 lines 35-58); wherein presenting said media file content and said ad file content includes presenting subsequent pages of said media file content, responsive to user input, while said ad file content is being presented (see col. 10 lines 16-33); wherein said media file content and said ad file content are both presented in the same format; wherein said media file content and said ad file content are both presented in audio format; wherein said media file content and said ad file content are both presented in video format; wherein said media file content and said ad file content are both presented in print format; wherein said media file comprises a real time broadcast; wherein said ad file includes user interactive content (see col. 10 line 1-67, col. 4 lines 14-33).

Regarding claims 40-43 Strietzel teaches receiving a media file from said user; associating an ad requirement with said media file; and providing said media file to another user; whereby the content of said media file can be presented to said other user with ad file content; wherein said media file is received from the provider of said ad file (see col. 9 lines 7-23);

wherein at least a portion of said media file is received via a peer-to-peer transfer; comprising providing feedback to said user to create the impression that said media file is being received from the provider of said ad file (see 16 lines 57 to col. 17 line 7).

Regarding claim 44 Strietzel teaches receiving updated ad files for use with subsequent presentation of media files (see col. 4 lines 1-33, col. 5 lines 40-67).

Regarding claims 45-54, 78-79 and 101, Strietzel teaches receiving media file identifiers associated with media files that should no longer be presented (see col. 5 lines 39-67); further comprising receiving a new media file identifier associated with a new media file that should be substituted for an existing media file; further comprising associating an identifier with each media file, said identifier being uniquely indicative of a work of authorship contained in said media file; wherein said step of receiving a copy of said media file includes receiving a copy of said media file in an encrypted format; decrypting said media file; and providing said decrypted media file to a media player; further comprising restricting access to said decrypted media file; wherein said step of receiving said ad file includes receiving a copy of said ad file in an encrypted format; said step of presenting said media file content and said ad file content includes dividing said media file into a plurality of segments, and presenting ad file content between said segments (see col. 13 lines 50-67).

Regarding claims 55, 80 and 100 Strietzel teaches presenting a graphical user interface representing a media player to said user, said interface including: a first tab indicative of a first media type; and a second tab indicative of a second media type; and whereby user selection of said first tab results in the presentation of an active window for the presentation of a media file of

said first type, while a media file of said second type is presented in background (see col. 14 lines 35-58).

Regarding 56-61, 89 and 90 Strietzel teaches further comprising making a record of media files that have been presented to said user; transmitting said media file presentation records to a provider of said ad files; further comprising selecting subsequent ad files based at least in part on said media file presentation records; requiring that said ad file content be presented in order to present said media file content; and relaxing the requirement for presenting said ad file for the remainder of a single media presentation session after said ad file has been presented (see col. 4 lines 14-33, col. 10 lines 55-67, col. 11 lines 1-35).

Regarding claims 104-106 Strietzel teaches providing media files containing copyrighted works; providing ad files; providing a media player operative to combine and present the content of said media files with the content of said ad files; and providing a free license to consumers to present said media files and said ad files with said media player; further comprising authorizing said consumers to reproduce and transfer said media files free of charge; monitoring the presentation of said ad files to said consumers; and conferring a benefit on particular ones of said consumers based at least in part on the presentation of said ad files to said particular consumers (see col. 16 lines 57-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strietzel further in view of Eyer et al. (US 6,588,015).

Regarding claims 86-88, Strietzel does not specifically teach wherein said step of presenting said ad file content to said user includes ensuring that said ad file content is presented in its entirety include disabling media player playback controls, it is taught in Eyer (see col. 6 lines 50-61, col. 16 lines 46-59, col. 18 lines 48-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the control in Strietzel as in Eyer for the intended purpose of making sure that the user or viewer listens or views the advertising message paid by the advertiser. It would have been obvious to one of ordinary skill in the art to also control the volume so that the viewer would listen to the message.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Landsman et al. (US 6,687,373 B2) teaches embedding advertising tag into a referring web page.

Janacek et al. (US 6,684,248 B1) teaches preloading advertisements or other contents into a storage device and inserting one of the preloaded advertisements at an insertion point in a content received from a server.

Cook et al. (US 6,338,044 B1) teaches distributing entertainment programming with embedded advertising in which the entertainment programming is customized according to consumer's states preferences and demographics.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622